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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,849	11/07/2000	Alan S. Fisher	2043.086US2	8858
49845 7590 08/06/2008 SCHWEGMAN, LUNDBERG & WOESSNER/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER AKINTOLA, OLABODE				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 08/06/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

Office Action Summary

Application No.

09/706,849

Applicant(s)

FISHER ET AL.

Examiner

OLABODE AKINTOLA

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22, 24-30, 32-39, 41-48 and 50-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22, 24-30, 32-39, 41-48 and 50-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/3508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/23/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-19,21-22, 24, 26-27, 29-30, 32-33, 35-36, 38-39, 41-42, 44-45, 47-48, 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (USPN 5845265) ("Woolston") in view of Brown (USPN 5794219) ("Brown")/ Fraser et al (US 5329589) ("Fraser")

Re claims 18, 26, 35 and 44: Woolston teaches computer system for conducting an auction through a computer network, the system comprising: a posting means for posting to a

computerized merchandise catalog information that is accessible through the computer network, the information describing each lot in a plurality of lots available for auction, each lot including at least one item (col. 3, lines 8-67, col. 4, lines 10-27, col. 5, lines 48-55), the posting means available to add a lot for auction during an auction of another lot, wherein the information related to items in each lot is substantially continuously updated in the merchandise catalog as items in each lot are made available for auction (col. 7, lines 16-30); a bid receiving means for receiving a bid for at least a portion of a lot of the plurality of lots (col. 6, lines 21-29); a bid validation means for examining the bid (col. 6, lines 37-44); and a bid categorizing means for determining whether the bid is successful or unsuccessful (col. 6, lines 30-33, col. 10, lines 33-63), and storing the bid in a bid database (col. 6, lines 21-44).

Woolston does not explicitly teach a bid validation means for examining and validating a characteristic of the bid during and prior to a close of the auction, wherein the characteristic is a bid format. Brown/Fraser teaches a bid validation means for examining and validating a characteristic of the bid during and prior to a close of the auction, wherein the characteristic is a bid format (Brown: col. 7, lines 19-31; Fraser: col. 14, lines 16-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston to valid bid formats as taught by Brown/Fraser. One would have been motivated to do so in order to ensure that the information in the bid is valid.

Re claims 19, 27, 36 and 45: Woolston teaches an auction selection means for associating each lot of the plurality of lots with an auction format selected from a plurality of auction formats (col. 5, line 50)

Re claims 21, 29, 38 and 47: Woolston does not explicitly teach wherein bid-receiving means receives the bid from a bid form. Brown teaches wherein bid-receiving means receives the bid from a bid form (Figures 5, 6 and 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston to bid forms as taught by Brown. One would have been motivated to do so in order to provide a standard format for which bidder enter their bids.

Re claims 22, 30, 39 and 48: Woolston teaches wherein the posting means is adapted to receive a message posted through the computer network corresponding to a lot and to post the message in association with the descriptive information for that lot.

(Figure 13)

Re claims 24, 32, 33, 41, 42, 50 and 51: Woolston teaches wherein the bid receiving means is for receiving bids on at least two lots that are simultaneously open for auction, the at least two lots having different associated auction formats, and wherein the bid categorizing the means is for automatically categorizing the received bids as successful or unsuccessful in accordance with the associated auction format for each lot (col. 11, lines 6-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 25, 34, 43 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston.

Re claim 25, 34, 43 and 52: Woolston does not explicitly teach proxy bidding. Official notice is hereby taken that the concept of proxy bidding is old and well known in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston to include this feature. One would have been motivated to do so in order allow participant to set maximum bids without monitoring the auction.

Support for this official notice can be found in Mackinnon, D. J. ("Playing the Auction Game"; SU2 Edition, Toronto Star, Ont.: Oct. 4, 1987. pg E.1) at page 3 of 3, paragraph 26.

Claims 20, 28, 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Huberman (US 5826244) ("Huberman").

Re claims 20, 28, 37 and 46: Woolston does not explicitly teach an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction.

Huberman teaches an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction (col. 10, lines 48-61).). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston to include this feature as taught by Huberman. One would have been motivated to do so in order to allow for flexibility taking into account customer preferences and the nature and characteristics of the item being auctioned.

Response to Arguments

Applicant's arguments filed 5/23/2008 have been fully considered but they are not persuasive.

Applicant argues that Brown and/or Fraser fail to teach "a bid validation means for examining and validating a characteristic of the bid during and prior to a close of the auction, wherein the characteristic is a bid format". Examiner respectfully disagrees. Examiner interprets this limitation in light of the specification (page 14, line 22 through page 15, line 7). The

specification discloses that the bid validator 21 examines the bid information entered by the customer on the bid form 20 to ensure that the bid is properly *formatted*, all necessary data is present and the data values entered look credible.

Brown at col. 7, lines 19-31 and col. 7, line 50 through col. 8, line 3 discloses that a bid entry form (having four fields with bidder name, bidder identification number, bid amount and bid designation) is completed and forwarded to a central computer. The central computer queries the bidder database to verify that the bid (bidder name and bidder identification number is valid) is credible. Otherwise, the bidder is notified of the error in the bid information. The central computer ensures that the information in the bid form is credible by verifying the bidder name and bidder identification number matches the registration record. An entry of a bidder name in the bidder identification number field and an entry of the bidder identification number in the bidder name field will be rejected by the system.

Fraser explicitly teaches validation of bids in an auction. Although, Fraser did not specifically recite bid format, Examiner interprets Fraser validation as ensuring that the bid is properly formatted, all necessary data is present and the data values entered look credible.

Furthermore, neither the specification nor the claim defines what the “format” of the bid is.

Conclusion

All claims are drawn to the same invention claimed in the earlier application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds

and art of record in the next Office action if they had been entered in the application prior to the entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691